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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/506,795
Filing Date: February 18, 2000
Appellant(s): BETHUNE ET AL.

MAILED

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GROUP 1700

Andrew J. Vance
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/22/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. (As correctly pointed out in applicant's brief, Claim 27 is cancelled).

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6306475	Stocq	10-2001
DE 2212995	Schafer	9-1973

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JP 05-294054	Iwao	11-1993
5,143,466	Moncrieff Baldwin	9-1992
3,861,986	Wochner	1-1975
6,379,761	Brandt	4-2002
5,376,417	Amano	12-1994
5,569,540	Hirose	10-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-26, 28-35, 72, 73, and 76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the specification as originally filed, or the French document incorporated by reference disclose that the pieces of material on the first surface of the supply strip backing have a different size than the pieces of material on the second surface.

Claims 1-5, 8-10, 12, 14, 21, 28, 73 and 76 are rejected (irrespective of 35 USC 112, first paragraph issues above) under 35 U.S.C. 103(a) as being unpatentable over Schafer (DE 2212995) in view of Stocq (US 6,306,475 B1) and Iwao (JP 05-294054).

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Schafer discloses a method of applying pieces of material to objects comprising: providing a material supply strip initially including a backing having first and second opposing surfaces and pieces of material removably arranged on both of the first and second surfaces and at least one applicator device, applying at least one piece of material from the first surface of the backing to at least one object with said at least one applicator device, and applying at least one piece of material from the second surface of the backing to at least one object with said at least one applicator device (See Figs. 3-4, Page 18, lines 10-12, Page 20, 2nd paragraph). Furthermore, Schafer discloses that it is known to use two different labels, such as labels of different shape which would imply certain dimensions being smaller or larger (see translation of Schafer, page 4, lines 22-23, from applicant's IDS, paper #13, submitted 9-26-2002).

Schafer does not disclose that the backing and the pieces of material are being formed of substantially the same material, or centering the pieces of material on the first and second surface of the supply strip relative to each other.

Stocq discloses that it is known in the formation of labels to utilize the same material for the backing and the pieces of material (i.e., the labels - see column 3, lines 53-56). Furthermore, Stocq discloses that the materials can comprise polypropylene and polyethylene. One in the art would appreciate Schafer, which is silent as to the materials used is intended to be used with any conventional and known piece and backing system, including one wherein the materials are the same, as shown in Stocq. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

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invention to have utilized a backing and pieces of material made from the same material as is conventionally known and shown in Stocq.

Iwao discloses centering the pieces of material on the first and second surface of the supply strip relative to each other. One in the art would immediately appreciate that such a relationship can improve handling of the web, especially with regard to splicing of webs, since centered labels can avoid splicing cuts of the labels by merely cutting the liner or supply strip. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized centered labels as in Iwao in order to improve handling of the web.

Regarding claim 2, the at least one applicator device includes at least one application station configured to apply pieces of material to objects, and wherein the applying of said at least one piece of material from the first surface and applying from the second surface includes passing the supply strip through the at least one application station.

Regarding claim 3, the at least one application station includes first and second application stations, and wherein the applying from the first surface includes passing the supply strip through the first application station, and the applying from the second surface includes passing the supply strip through the second application station.

Regarding claim 4, the supply strip is passed through the second application station after the supply strip is passed through the first application station.

Regarding claim 5, the at least one applicator device includes first and second sections, wherein the first surface being oriented to face the first section and the second

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surface being oriented to face the second section when the supply strip is passed through the first application station, the method further comprises re-orienting the supply strip so that the second surface faces the first section and the first surface faces the second section when the supply strip is being passed through the second application station (See Fig. 4).

Regarding claim 8, the method further comprises winding the supply strip into a roll on a spool after at least one of the applying from the first surface and applying from the second surface.

Regarding claim 9, the supply strip is initially in the form of a roll on a spool, wherein the method further comprises feeding the supply strip from the spool.

Regarding claim 10, the method further comprises winding the supply strip into a roll on a second spool after at least one of the applying from the first surface and applying from the second surface.

Regarding claim 12, the supply strip is initially in the form of a roll on a first spool, the method further comprises: feeding the roll of supply strip from the first spool to the first application station, and winding the supply strip into a roll on a second spool after the supply strip is passed through the second application station.

Regarding claim 14, wherein at least one piece of material from the first surface and at least one piece of material from the second surface are applied to a group of common objects.

Regarding claim 21, the pieces of material are labels.

Regarding claim 28, Stocq discloses using polyethylene.

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Regarding claim 73, the first applicator device is used for applying at least one piece of material from the first surface and the second applicator device is used for applying at least one piece of material from the second surface.

Regarding claim 76, Schafer further discloses the additional limitation that the pieces of material on the first surface are positioned on the backing substantially opposite to corresponding pieces of material on the second surface such that outer edges of the opposing pieces of material do not line up with each other (see Figures). Schafer also discloses different shapes, i.e., sizes, and Iwao discloses centering. See the rejection of claim 1 above.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer, Stocq and Iwao as applied to claim 5 above, and further in view of Moncrieff Baldwin et al. (USPN 5,143,466 and henceforth referred to as Baldwin). Schafer discloses re-orienting the supply strip between application stations. Schafer is silent to twisting. One in the art would appreciate twisting the supply strip to reposition the second surface. It is known and conventional to twist a strip approximately 180 degrees to reposition the second surface of said strip as shown, for example, by Baldwin (See Fig. 1, items 34, 61, 62, 51 and Col. 4, lines 27-32). It would have been obvious to one of ordinary skill in the art at the time of the invention to twist the supply strip of Schafer to reposition the second surface as shown by Baldwin in order to simplify the conveying system of Schafer to resemble that of a straight line, therefore eliminating the need for guide rollers that alter the direction of the conveyance path of the supply strip.

Claims 16, 20 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer, Stocq and Iwao as applied to claims 1 and 14 above, and further in view of Wochner (USPN 3,861,986). Schafer may be silent to the types of material on the supply strip. One in the art would appreciate pieces of material that are different may be supplied. It is well known and conventional to provide a supply strip having different pieces of material as shown, for example, by Wochner (See Col. 1, lines 55-62). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide pieces of material on the first surface different from pieces of material on the second surface as applying different pieces of material to objects is well known and conventional as shown by Wochner.

Regarding claim 34, bottles as the objects are disclosed (See Wochner, Col. 1, lines 5-10).

Claims 22, 24-26, 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer, Stocq and Iwao as applied to claims 1 and 21 above, and further in view of Brandt et al. (USPN 6,379,761). Schafer may be silent to the particular properties of the supply strip, backing and labels. One in the art would appreciate such properties are well known and conventional for supply strips that provide labels to objects. It is well known and conventional to provide a supply strip with such properties as shown, for example, by Brandt et al. (See Col. 3, lines 2-4, 44-46, Col. 5, lines 10-16, Col. 6, lines 61-63, Col. 8, lines 36-37). It would have been

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obvious to one of ordinary skill in the art at the time of the invention to provide such a supply strip, backing and labels with properties as those disclosed by Brandt et al. as they are well known and conventional properties of such and also to provide labels that can be easily and economically removed and re-applied (See Col. 2, lines 9-14).

Further regarding claim 33, the adhesive that removably adheres the pieces of material in Brandt et al. is considered to fall within the range of thickness as claimed. One in the art would appreciate the thickness of the adhesive of Brandt et al. as depicted is thinner than the backing (See Fig. 1, items 1 and 2).

Claims 23 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer, Stocq and Iwao as applied to claim 21 and above, and further in view of Amano et al. (USPN 5,376,417). Schafer may be silent to the particular material of the labels. One in the art would appreciate choosing any conventional label as is known in the art. Amano et al. disclose conventional labels made of PET (polyethylene terephthalate) (See Col. 1, lines 30-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to choose PET as the material for the label as is well known and conventionally used for labels that are applied to objects.

Further regarding claim 35, PET is known to be transparent. One of ordinary skill in the art would appreciate conventional labels may be transparent and that PET labels may be transparent.

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Claim 28 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer, Stocq and Iwao as applied to claim 1 above, and further in view of Brandt et al. and Hirose. Schafer may be silent to the particular material used for the backing. Brandt et al. disclose conventional backings may be formed from many different polymer substrates, and cite examples such as polypropylene and polyester (See Col. 10, lines 4-8). Brandt et al. is silent to PET. One in the art would appreciate PET is included in the discussion by Brandt et al. and is a conventional polymer substrate used as a backing. Hirose et al. disclose polyesters and polypropylene may be used as backings, and provides a specific example to PET (See Col. 3, lines 55-65 and Col. 6, lines 40-42). One in the art would appreciate such materials are well known and conventional alternatives. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a PET backing as is a well known and conventional material used for supply strips as shown by Brandt et al. and supported by Hirose et al.

(10) Response to Argument

A. Response to arguments to rejection of claims 1-26, 28-35, 72, 73 and 76 under 35 USC 112, first paragraph.

With regard to applicant's arguments as to the 35 USC 112, first paragraph rejections, this rejection maintained. It is noted that applicant cites page 14 of the original specification as support for the claims, which recites that "the invention could be

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practice[d] with labels having many different configurations (e.g., different size, different shape, different labeling information)” (emphasis by applicant in page 3 of the remarks of the response filed 8-27-2003). Furthermore, it is noted that the specification that the labels might be a different format. However, the example the specification shows is that of the labeling information differing (for example, page 12, lines 11-16). The specification does not explicitly state that the labels on one backing material has labels on a first surface of the backing material of one size, and labels on the second surface of the backing material of another size. The statement that the labels can be a different size as stated in page 14 can be interpreted many ways, and one of ordinary skill in the art, especially when faced with a disclosure that shows examples wherein the labels on both sizes of the backing material are the same, would interpret the statement to indicate that from processing run to processing run, the apparatus can use different configurations of labels, but inside a processing run, the labels are the same size.

It should be noted that applicants entire argument rests on how they perceive one of ordinary skill in the art would interpret page 14, lines 9-11, of the original specification, as repeated below.

One of ordinary skill in the art would recognize, however, that the invention could be practices (sic) with labels having many different configurations (e.g., different size, different shape, different labeling information).

However, this section does not explicitly provide support and should not be stretched to provide support for claims wherein the pieces of material on the first surface have a different size than the pieces of material on the second surface.

For this reason, the rejection of claims 1-26, 28-35, 72, 73, and 76 under the first paragraph of 35 USC 112 should be upheld.

B. Response to arguments to rejection of claims 1-5, 8-10, 12, 14, 21, 28, 73 and 76 under 35 USC 103(a).

On pages 17, although applicant admits that lwao depicts lining up the edges of the labels on either side (page 17, lines 18-20), applicant then argues that lwao does not show centering of the labels. This is not persuasive, as labels of similar shape that are lined up on the sides of the label strip would inherently be centered upon each other.

On page 18-19, applicant alleges that Stocq does not disclose the pieces of material being made of the same material as the backing. However, Stocq clearly discloses labels (for example, Figure 6c), and embodiments that use a backing, or disposable, layer (release line 14, made of elements 9, the liner and 13, a release material). Stocq also discloses that the liner 9 can be identical to face sheet 11. This provides support for Stocq disclosing that label and liners can be of the same material.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge to utilize the labels in a configuration as in Iwao (such that they are centered) and in Stocq (such that the labels and liner are made of the same material) would be generally available to one of ordinary skill in the art.

Furthermore, on page 20, applicant also argues, with respect to dependent claim 5, that the primary reference Schafer does not disclose re-orienting the supply strip. However, this is not persuasive, because Figure 4 of Schafer clearly shows reorienting of the strip.

Further, on page 20, applicant argues that Stocq does not disclose polyethylene terephthalate (PET). However, Stocq discloses clear polyethylene, which can include PET. In any event, this claim is additionally rejected under Hirose, which discloses PET in transfer materials.

As to claims 1-4, 8-10, 12, 14, 21, and 73, the arguments as to these claims are based on overcoming parent claim 1 and should be upheld for the same reason.

C. Response to arguments to rejection of claims 6 under 35 USC 103(a).

The arguments as to the rejection of claim 6 are based on overcoming parent claim 1 and should be upheld for the same reason.

D. Response to arguments to rejection of claims 16, 20 and 34 under 35 USC 103(a).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that Wochner does not disclose labels on both sides of the backing. However, Wochner is not relied upon for this, but rather relied upon for teachings that it is known to apply different labels from each strip. Schafer and Iwao both disclose and are used to show the concept of labels on both sides of the strip - Wochner is merely cited to show that application of "different labels" is known.

Similarly, Wochner also discloses that the labels on the strip can be different. To rephrase applicant's argument with respect to the new matter issue on page 11-13 of the appeal brief, one of ordinary would appreciate that "different labels" as recited in Wochner also includes that the labels wherein the materials on the first surface that differ from the pieces of material from the second surface.

As to claim 34, which is directed towards application of labels to bottles, applicant presents no arguments. Therefore, the arguments as to the rejection of claim 34 are based on overcoming parent claim 1 and should be upheld for the same reason.

E. Response to arguments to rejection of claims 22, 24-26, and 29-34 under 35 USC 103(a).

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The arguments as to the rejection of claims 22, 24-26 and 29-34 are based on overcoming parent claim 1 and should be upheld for the same reason.

F. Response to arguments to rejection of claims 23 and 35 under 35 USC 103(a).

The arguments as to the rejection of claims 23 and 35 are based on overcoming parent claim 1 and should be upheld for the same reason.

G. Response to arguments to rejection of claim 28 under 35 USC 103(a).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that Hirose does not disclose the polyethylene terephthalate (PET) labels being used with applicator device, supply strip, and backing. However, Schafer, Iwao, and Stocq disclose the applicator device, supply strip, and backing. Hirose is merely cited to show that PET is used in labels.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


George Koch

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